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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/756,885 | 01/09/2001 | Muhammad Chishti | 18563-002300 | 6714 |
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| TOWNSEND AND TOWNSEND AND CREW, LLP (018563) TWO EMBARCADERO CENTER, EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834 | | | EXAMINER NAJARIAN, LENA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3626 | |

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/756,885

Applicant(s)

CHISHTI ET AL.

Examiner

Lena Najarian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 and 46-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 46-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 9/12/05. Claims 1-30 and 46-59 remain pending. Claims 1, 13, 14, 26, 27, 46, and 55-57 have been amended. Claims 31-45 and 60-70 have been canceled.

Claim Objections

2. The objection of claims 26-27 and 55-57 is hereby withdrawn due to the amendment filed 9/12/05.

Claim Rejections - 35 USC § 112

3. The rejection of claim 13 under 35 U.S.C. 112, second paragraph, is hereby withdrawn due to the amendment filed 9/12/05.

Claim Rejections - 35 USC § 101

4. The rejection of claims 1-25, 28-30, 46-54, and 58-59 under 35 U.S.C. 101 is hereby withdrawn due to the amendment filed 9/12/05.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruin-Ashton (6,014,629) in view of Falchuk et al. (US 2002/0152096 A1), and further in view of Tawil (5,225,976).

(A) Claim 1 has been amended to now recite "accessing an electronic database having information comprising a number of procedures performed by each of the group of certified practitioners" and providing to the identified individual patients a list of certified practitioners, "selected from the electronic database...." As per these features, DeBruin-Ashton teaches an electronic database (see Fig. 1) and teaches selection algorithms for certain physicians to be represented in a higher proportion (col. 12, lines 47-54).

DeBruin-Ashton does not disclose the number of procedures performed by each of the group of certified practitioners.

Tawil discloses tracking the number of times the provider has performed the procedure (col. 3, lines 3-21 of Tawil).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Tawil within DeBruin-Ashton and Falchuk. The motivation for doing so would have been to include background information on providers available for review by the patient to assist the patient's decision-making process (col. 4, lines 57-59 of Tawil).

The remainder of claim 1 is rejected for the same reasons given in the previous Office Action, and incorporated herein.

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(B) The amendment to claim 13 was apparently made to overcome 112, 2nd paragraph issues set forth in the prior Office Action. However, these changes do not affect the scope and breadth of the claim as originally presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action. As such, the claim is rejected under the same rationale given in the prior Office Action, and incorporated herein.

(C) Claims 2-5 and 12 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

7. Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruin-Ashton (6,014,629) in view of Falchuk et al. (US 2002/0152096 A1) as applied to claim 1 above, in view of Tawil (5,225,976), and further in view of Kurzius et al. (6,385,620 B1).

(A) Claims 6-11 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

8. Claims 14, 16-19, 21-22, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruin-Ashton (6,014,629) in view of Joao (US 2002/0032583 A1).

(A) Claim 14 has been amended to now recite "accessing an electronic database having information comprising performance criteria for each of the group of certified dental practitioners; and" providing to the identified patients referral lists of certified practitioners, "selected from the electronic database." As per these features, DeBruin-

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Ashton discloses an electronic database having information (see Fig. 1 and abstract of DeBruin-Ashton).

DeBruin-Ashton does not disclose performance criteria for each of the group of certified dental practitioners.

Joao teaches a database containing statistical information such as treatment success rates and information on the treatment providers (para. 161 of Joao).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Joao within DeBruin-Ashton. The motivation for doing so would have been to provide important information about healthcare-related professionals (para. 29 of Joao).

The remainder of claim 14 is rejected for the same reasons given in the previous Office Action, and incorporated herein.

(B) Claims 16-19, 21-22, and 29-30 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruin-Ashton (6,014,629) in view of Joao (US 2002/0032583 A1) as applied to claim 14 above, and further in view of Tawil (5,225,976).

(A) Claim 15 has not been amended and is rejected for the same reasons given in the previous Office Action, and incorporated herein.

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10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruin-Ashton (6,014,629) in view of Joao (US 2002/0032583 A1) as applied to claim 14 above, and further in view of Falchuk et al. (US 2002/0152096 A1).

(A) Claim 20 has not been amended and is rejected for the same reasons given in the previous Office Action, and incorporated herein.

11. Claims 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruin-Ashton (6,014,629) in view of Joao (US 2002/0032583 A1), and in view of Tawil (5,225,976), as applied to claims 14-15 above, and further in view of Kurzius et al. (US 6,385,620 B1).

(A) Claims 23-25 and 28 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

(B) Referring to claims 26 and 27, DeBruin-Ashton and Joao do not disclose wherein each tier is defined by a threshold number of procedures performed over a selected period of time and wherein each tier is defined by an aggregate number of procedures performed.

Tawil discloses tracking the number of times the practitioner has performed the procedure within a given amount of time (col. 3, lines 11-13 of Tawil).

Kurzius discloses wherein candidates are assigned to at least three tiers (col. 17, lines 48-52 of Kurzius; the Examiner interprets "beginner, intermediate, full-understanding, or expert" to be a form of "tiers").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Tawil and Kurzius within DeBruin-Ashton and Joao. The motivation for doing so would have been to provide information for review by the patient to assist the patient's decision-making process (col. 4, lines 57-59 of Tawil) and to sort the practitioners by proficiency level (col. 17, lines 48-52 of Kurzius).

12. Claims 46-49, 51-52, 55-56, and 58 rejected under 35 U.S.C. 103(a) as being unpatentable over Tawil (5,225,976) in view of Falchuk et al. (US 2002/0152096 A1). (A) Claim 46 has been amended to now recite maintaining a patient referral directory "in an electronic database having information comprising the number of times each certified practitioner has performed the procedure," wherein "certified" practitioners "selected from the electronic database" are prioritized on "a" list based on the number of times each "certified practitioner" has performed the procedure. As per these features, Tawil discloses a database that tracks the number of times the provider has performed the procedure (col. 3, lines 3-21 of Tawil).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Tawil within Falchuk. The motivation for doing so would have been to include background information on providers available for review by the patient to assist the patient's decision-making process (col. 4, lines 57-59 of Tawil).

The remainder of claim 46 is rejected for the same reasons given in the previous Office Action, and incorporated herein.

(B) Claims 47-49, 51-52, and 58 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

(C) Referring to claims 55 and 56, Tawil discloses wherein the number of times the procedure is performed is measured periodically over a fixed time interval and the directory periodically updated and wherein the practitioners are not ordered within a tier (col. 3, lines 3-21 of Tawil).

13. Claims 50 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tawil (5,225,976) in view of Falchuk et al. (US 2002/0152096 A1) as applied to claims 46 and 58 above, and further in view of DeBruin-Ashton (6,014,629).

(A) Claims 50 and 59 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

14. Claims 53-54 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tawil (5,225,976) in view of Falchuk et al. (US 2002/0152096 A1) as applied to claims 46 and 52 above, and further in view of Kurzius et al. (6,385,620 B1).

(A) Claims 53-54 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

(B) Referring to claim 57, Tawil discloses tracking the number of procedures performed (col. 3, lines 3-21 of Tawil). However, Tawil does not expressly disclose ranking the practitioners within each tier based on this data.

Kurzius discloses placing candidates into tiers based on experience and proficiency level (col. 17, lines 48-52 of Kurzius).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Kurzius within Tawil and Falchuk. The motivation for doing so would have been to sort the practitioners by proficiency level (col. 17, lines 48-52 of Kurzius).

Response to Arguments

15. Applicant's arguments filed 9/12/05 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 9/12/05.

16. Applicant's arguments with respect to claims 1 and 46 have been considered but are moot in view of the new ground(s) of rejection.

(1) Applicant argues that while CME credits may be necessary for a physician to maintain an active medical license, the awarding of CME credits by consultation of a primary care physician with a specialist physician, as taught by Falchuk, distinctly differs from certifying a group of practitioners to perform a particular medical procedure, as required by the current claims. As such, Falchuk fails to teach certifying a group of practitioners to perform a medical procedure, as recited in current claim 1.

(2) Applicant argues that Tawil is directed to a health benefit processing system designed to process health benefits claims for insurance purposes, which is

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distinguished from the current disclosure. The entire Kurzius disclosure is directed to employment candidate recruiting and is silent with respect to referring patients to medical practitioners.

(3) Applicant argues that Joao does not teach certifying dental practitioners to perform a dental procedure, as alleged by the Examiner. Joao is directed to an apparatus for providing healthcare information for payer and provider communication, including a central processing computer. It is submitted that mere reference to “dental training” in the context of database storage information, without more, is insufficient to teach certifying dental practitioners to perform a dental procedure as recited in the current claims and disclosed throughout the specification.

(A) As per the first argument, the Examiner disagrees as Falchuk teaches educating the practitioners and testing the practitioners (see para. 21 and para. 30 of Falchuk). The Examiner believes these passages address Applicant’s certifying of practitioners.

(B) As per the second argument, while Tawil is directed to a health benefit processing system, it also contains a database with provider information. The purpose of the database is to assist the patient’s decision-making process (see col. 4, lines 57-59 and col. 3, lines 3-13 of Tawil). The background information concerning the providers allows the patient to make a more informed selection (see col. 4, line 66 – col. 5, line 2 of Tawil). In response to applicant’s argument that Kurzius is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant

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was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Kurzius and the Applicant's invention are directed to assigning tiers to people based on experience level, to perform a job.

(C) As per the third argument, the Examiner disagrees as Joao is also directed to the training of healthcare professionals (para. 167 of Joao). Joao teaches that dentists are provided training (see para. 167 of Joao). As such, Joao teaches certifying dental practitioners.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

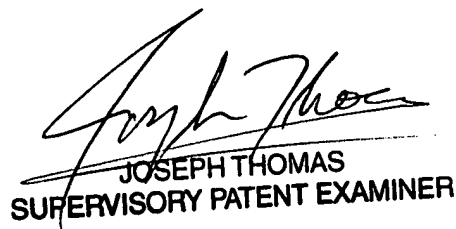
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lena Najarian whose telephone number is 571-272-7072. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LN

In
11-18-05


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER